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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,509	04/06/2000	Phil Wyatt	MCO-P-00-003	9084
29013	7590	10/12/2005	EXAMINER	
PATENTS+TMS, P.C.			PASS, NATALIE	
2849 W. ARMITAGE AVE.			ART UNIT	
CHICAGO, IL 60647			PAPER NUMBER	

3626

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/544,509

Applicant(s)

WYATT, PHIL

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Board Decision of 18 March 2005 reversing the decision of the Examiner. Claims 1-20 are pending.

2. In the decision by the Board of Patent Appeals and Interferences mailed 18 March 2005 in paper number 16, the rejections of claims 1-20 were reversed. The reason for the reversal of claims 1-20 was, in substance, that the combined applied references do not contain the limitations recited in claims 1 and 15, since neither reference teaches or suggests a system that discloses "in response to a query related to a medical condition, a medical resource, such as a doctor or a hospital, that treats the medical condition queried." (See for example page 5 of BPAI decision). The Examiner, however, has specific knowledge of a particular reference which demonstrates such obviousness. Therefore, under 37 CFR 1.198, prosecution is hereby reopened (see MPEP 1214.04). The new grounds of rejection are detailed below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Business Wire article "Specialty care Network Announces Internet Strategy; New HealthGrades.com Site to Offer Provider and Health Plan Rating Information." June 30, 1999, Business wire, p1519. hereinafter known as HealthGrades in view of Applicant's admissions in the "Background of the Specification" section of the Specification.

(A) As per claim 1, HealthGrades teaches a method for matching medical condition information with a medical resource, the method comprising the steps of:

providing a computer network (such as the Internet) having a plurality of remote computers and at least one remote server wherein the remote server hosts a website

(HealthGrades, paragraph 5);

accessing the website or "portal for consumers to locate a wealth of information on the leading hospitals, physicians and health plans" (reads on "via an individual remote computer on the computer network") (HealthGrades, paragraph 5);

providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness" (reads on "inputting a query or request for data into the website wherein the query relates to a medical condition") (HealthGrades, paragraph 5);

searching the database for the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition queried; Examiner interprets HealthGrades' teaching of providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness," (HealthGrades, paragraph 5), as reading on this limitation.

Although HealthGrades teaches “applying complex and proprietary Company-developed algorithms to collected provider data” (HealthGrades, paragraph 3), HealthGrades fails to explicitly disclose

providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions.

However, the above features are well-known in the art, as evidenced by Applicant’s own disclosure.

In particular, Applicant’s specification teaches “...generally known to provide information on a computer network ... [...] ... allow an individual to access a database...[that] ... may contain the information in an organized manner so that an individual on a remote computer may access the website and search the database for particular information” (see Specification, page 1, lines 21-30) and “it is generally known to provide access to databases that may contain medical information” (see Specification, page 2, lines 3-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of HealthGrades to include providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions, as disclosed by Applicant’s own specification, with the motivations of allowing “consumers [to] find objective data regarding the best hospitals and physicians to treat their illness,” based on “collected provider data” (HealthGrades, paragraphs 3, 5).

(B) As per claims 2-8, HealthGrades teaches a method as analyzed and discussed in claim 1 above, further comprising the step of

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providing a “portal for consumers to locate a wealth of information on the leading hospitals, physicians and health plans” (reads on “outputting the information to the individual remote computer” (HealthGrades, paragraph 5); and

wherein the medical disorders or conditions relate to diseases (HealthGrades, paragraph 3);

further comprising the step of providing medical procedure information to one of the computers (HealthGrades, paragraph 3);

searching the database for medical procedure information (HealthGrades, paragraph 3);

disclosing on one of the remote computers a practitioner or provider that treats the medical condition queried (HealthGrades, paragraphs 3, 5);

disclosing to the individual remote computer the medical facility that treats the medical condition queried (HealthGrades, paragraphs 3, 5);

further comprising the step of disclosing specific medical resource information wherein the specific medical resource information includes “where and to whom to go for the best care” and “about the appropriate procedure to treat the disease” (reads on “a name of the medical resource, a location, contact information and services offered”) (HealthGrades, paragraph 3).

(C) As per claims 9-14, HealthGrades teaches a method as analyzed and discussed in claim 1 above, further comprising the step of

further comprising the step of linking one of the remote computers to a specific website relating to the medical resource (HealthGrades, paragraphs 5-6);

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wherein the information discloses a plurality of medical resources that treat the medical condition queried; Examiner interprets HealthGrades' teaching of providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness," (HealthGrades, paragraph 5), as reading on this limitation;

wherein the query includes disease information (reads on "identifying information of an individual using the website") (HealthGrades, paragraphs 3-6) wherein search results disclosing medical resources match the identifying information to the medical resource (HealthGrades, paragraphs 3-8);

disclosing a plurality of medical resources that treat the disorder queried; Examiner interprets HealthGrades' teaching of providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness," (HealthGrades, paragraph 5), as reading on this limitation; and

ranking the medical resources based on how the medical resources match the query; Examiner interprets HealthGrades' teaching of providing a web site that "rates virtually every U.S. hospital based on specific performance..." (HealthGrades, paragraph 4) as reading on this limitation;

providing a plurality of websites on the computer network (HealthGrades, paragraph 5);

accessing any one of the plurality of websites via the remote computer (HealthGrades, paragraph 5); and

searching the database via any one of the plurality of websites (HealthGrades, paragraphs 5-6);

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providing a plurality of databases on a plurality of remote servers wherein the databases store the information relating to the medical conditions (HealthGrades, paragraphs 5-8); linking the databases via the computer network (HealthGrades, paragraphs 5-6); and searching the databases for the information (HealthGrades, paragraphs 5-8).

(D) Claims 15-20 differs from method claims 1-4, 6, and 9, in that they recite a system rather than a method for matching medical condition information with a medical resource.

System claims 15-20 repeat the subject matter of claims 1-4, 6, and 9, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-4, 6, and 9 have been shown to be fully disclosed by the teachings of HealthGrades in the above rejection of claims 1-4, 6, and 9, it is readily apparent that the system disclosed by HealthGrades includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-4, 6, and 9, and incorporated herein.

Conclusion

5. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

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For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication
and do NOT sign the communication.

After Final communications should be labeled "Box AF."


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

October 6, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

APPROVED
JOHN J. LOVE
DIRECTOR TC 3600
